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JUN 24 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Furuumi, et al.
Application No. 10/722,781
Filed: 25 November 2003
For: INFORMATION PROCESSING SYSTEM,
STORAGE SYSTEM, STORAGE DEVICE
CONTROL APPARATUS AND PROGRAM

DECISION ON PETITION
FOR ACCELERATED
EXAMINATION UNDER
M.P.E.P. §708.02(VIII)

This is a decision on the petition filed 30 December 2004, under 37 C.F.R. 102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **DISMISSED**.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;
- (d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petition filed 30 December 2004 fails to adequately meet requirement (e) as set forth above. Responsive to requirement (e), applicant must provide a “detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.” Petitioner should ensure that the above discussion is directed to *how the language of each of the independent claims are specifically distinguishable and patentable from the references* provided pursuant to requirement (d) supra.

Applicant’s petition fails to discuss the **claimed limitations** with respect to the references in accordance with the requirements of 37 CFR 1.111 (b) and (c). The petition does not point out specific limitations in each of the independent claims that may distinguish the invention over the references. Petitioner simply recites all the independent claims and then proffers one permutation, summation of the claimed features with an averment that none of the references meet this language. This amalgamation of limitations precedes a list of reference-descriptions, and serves as the petition’s basis for distinguishing the independent claims from the given references. The permutation of claimed features, however, does not provide the requisite specificity regarding the limitations associated with each of the independent claims for correlation/contrast with the referenced prior art. Also, the feature summary appears to be presenting/arguing limitations in narrower terms than the limitations in claims 13 and 14. Hence, the summarized extraction is incongruous with all the claims and cannot fairly represent the limitations of each of the independent claims.

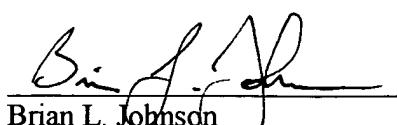
Filing for Accelerated Examination under MPEP § 708.02(VIII), requires Petitioner to provide a “detailed discussion of the references” that illuminates the salient prior art issues relative to the claimed subject matter. The instant petition, however, furnishes only a terse squib as the “discussion” for a number of the cited references. For example, in addressing references 1, 2, 3, et seq. the petition simply supplies a short abstract for each reference. Petitioner alludes to the references in broad terms, and fails to furnish the “detailed discussion of the references” in accordance with section (e) supra.

In the discussion of how the claims are patentable over the references, the petition must show, for each independent-claim, specific limitations that distinguish over each given reference in order to specify “how the claimed subject matter is patentable over the references.”

Petition to Make Special DISMISSED.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner’s docket to await treatment on the merits in the normal order of examination.



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